

REMARKS**Status of Claims**

Claims 1-36 are pending in the present application. Claims 1-3, 6-11 and 14-34 are withdrawn from consideration. Claims 4, 5, 12 and 13 are rejected. Claims 35 and 36 are added to further define the present invention. Claims 35 and 36 are significantly narrower in scope than claims previously considered by the Examiner. The presentation of claims 35 and 36 creates a new issue not previously considered by the Examiner.

Rejection of Claims 4, 5, 12 and 13 Under 35 U.S.C. 101; Rejection of Claims 4, 5, 12 and 13 Under 35 U.S.C. 112, First Paragraph

Claims 4, 5, 12 and 13 are rejected by the Examiner under 35 U.S.C. 101 for the reasons set forth on pages 2-3 of the Office Action. Claims 4, 5, 12 and 13 are rejected by the Examiner under 35 U.S.C. 112, first paragraph, for the reasons set forth on page 4 of the Office Action. These rejections are respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants traverse this rejection for the reasons of record. Applicants maintain that the rejection is based on the Examiner's personal opinion rather than upon art recognized scientific principles. If the Examiner would like to rely on his personal technical knowledge rather than upon the state of the art, then the Examiner is respectfully requested to submit a Declaration

attesting to that "evidence". Otherwise, Applicants' statement of utility should and must be accepted. Thus, the rejections under 35 U.S.C. 101 and 112, first paragraph, should be withdrawn by the Examiner as the Examiner has not set forth a prima facie case of lack of utility.

Rejection of Claims 4, 5, 12 and 13 Under 35 U.S.C. 102(b) Over Arriza

Claims 4, 5, 12 and 13 are rejected by the Examiner under 35 U.S.C. 102(b) over the Arriza reference for the reasons set forth on page 3 of the Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Examiner's position is that the instant claims do not clearly exclude the art-known splice form of the polypeptide. That is, the Examiner's position is that the Arriza et al. reference teaches the cDNA encoding the claimed amino acid. Applicants respectfully disagree.

The Arriza et al. reference merely refers to the original sequence. The Arriza et al. reference does not disclose or suggest the claimed splice variants of the invention. Contrary to the position taken by the Examiner, Applicants' invention does not encompass the sequence known in the art. Rather, the pending claims are directed to the sequences recited in the present application, which are the splice variants.

The Examiner is further requested to consider new claims 35 and 36.

Accordingly, in view of the remarks hereinabove, the rejection of claims 4, 5, 12 and 13 under 35 U.S.C. 102(b) over the Arriza reference should be withdrawn by the Examiner.

Rejection of Claims 4, 5, 12 and 13 Under 35 U.S.C. 112, Second Paragraph

Claims 4, 5, 12 and 13 are rejected by the Examiner under 35 U.S.C. 112, second paragraph, for the reasons set forth on page 4 of the Office Action. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The Examiner's position is that the instant claims do not clearly exclude the art-known splice form of the polypeptide. Applicants respectfully disagree.

Contrary to the position taken by the Examiner, the description at page 9, lines 1-2 of the present specification defines the original sequence. Moreover, the Table on page 21 of the present specification shows that the Mineralcorticoid (MCR_HUMAN) splice variant is expressly defined with reference to the original protein (e.g. "Replacement of 147 C-terminal amino acids, including part of the steroid binding domain of the **original** protein, by alternative 8 amino acids."

Finally, claims 35 and 36 should be free of this rejection.

Accordingly, in view of the remarks hereinabove, the rejection of claims 4, 5, 12 and 13 under 35 U.S.C. 112, second paragraph, should be withdrawn by the Examiner.


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$465.00 is being submitted with the Request for Continued Examination filed concurrently herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc. S. Weiner (Reg. No. 32,181) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By 

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Attachment(s)